

**REMARKS:**

Claims 1-37 are currently pending in the application.

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,154,738 to Call (hereinafter “*Call*”).

Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of U.S. Patent No. 7,272,626 to Sahai (hereinafter “*Sahai*”).

Applicant respectfully submits that all of Applicant’s arguments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**I. Rejection Under 35 U.S.C. § 102(b)**

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over *Call*.

Applicant respectfully submits that Applicant’s claims in their current form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Call*. Thus, Applicant respectfully traverses the Examiner’s rejection of Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102(b) over *Call*.

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628,631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the

reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

In rejecting Claim 1, the Examiner asserts that *Call* discloses the following:

a) access a first product classification schema, the first schema comprising a taxonomy that comprising a hierarchy of classes for categorizing one or more products [e.g., the use of cross-reference product servers at Abstract, line 18, etc., col. 11, lines 65- col. 12, lines 46], the first schema further comprising ontology associated with one or more of the classes [e.g., the use of XML metadata & Document Type Descriptor techniques at col. 25, lines 26 - 34, 53-66], each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier [e.g., the use of universal product code cross-referencing schema with domain name services over an Internet at col. 21, lines 6 - col. 22, lines 53, Fig 6 and associated texts];

(24 April 2009, Non-Final Office Action, page 3). Applicant respectfully disagrees with all of the above and draws the Examiner's attention to column 11, line 65 through column 12, line 20 of the specification of *Call*, provided below, on which the Examiner relies:

By way of example, in the bookselling industry, publishers, distributors, retailers, and libraries often require a database of bibliographic information which consists, for each book, of the book title, author name(s), publisher's name, publication date, type of book (hardcover, paperback, etc.), page count, recommended retail price(s), and ISBN number (which takes the form of a subpart of the EAN universal product code). To the extent the content and format of data records which describe particular classes of products in particular industries and trade groups have been previously adopted and placed in widespread use, those structured data records may advantageously be made available utilizing the present invention. This is preferably achieved in two ways: a data record (file) containing such field-structured information about each product which is designated by a universal product code is placed by the manufacturer in the directory it creates for that product. This structured data record is given a filename indicative of the format used to store the structured data. For example, each directory bearing a name corresponding to the EAN number for a book would preferably contain a file named "biblio.dat" which contains a single structured record containing bibliographic data describing that book.

Applicant respectfully submits that *Call* fails to disclose at least “***a first product classification schema . . . comprising a taxonomy comprising a hierarchy of classes categorizing one or more products***” as required by Claim 1. By contrast, the portion of *Call* relied upon by the Examiner merely discloses, among other things, examples of the types of

bibliographic information that a database may contain, such as book title, author's name, publisher's name, publication date, type of book, page count, recommended retail price, and ISBN number. The mere existence of these various types of bibliographic information in a database containing a *single structured record* is not analogous to a “*product classification schema...comprising a taxonomy [having] a hierarchy of classes categorizing one or more products,*” as recited in Claim 1. *Call* is silent and thus, provides no disclosure, of any relationship that may exist between the various types of bibliographic information and furthermore, does not teach, suggest or even hint at that these types of information are arranged in any particular way, such as for example, in a hierarchy of classes as required by Claim 1, except for stating that it contains a file named "biblio.dat" which contains a *single structured record* containing bibliographic data describing the book.

Thus, *Call* fails to disclose at least the limitation of Claim 1 of “*a first product classification schema . . . comprising a taxonomy comprising a hierarchy of classes categorizing one or more products.*” As such, Applicant respectfully submits that a proper rejection under 35 U.S.C. § 102 may not be maintained over *Call* and respectfully requests that the Examiner's rejections be withdrawn.

## **II. Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Call***

Applicant respectfully submits that the allegation in the Office Action that *Call* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Call* is considered to anticipate all of the elements in Claims 1-7, 9-18, 20-29, and 31-37. *A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.* MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of Applicant's claimed invention is identically shown in *Call*. For example, the Examiner asserts that the “*a first product classification schema . . . comprising a taxonomy comprising a hierarchy of classes categorizing one or more products,*” in Claim 1 is disclosed in *Call*. (24 April 2009

Non-Final Office Action, page 3). Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion.

Applicant respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Applicant respectfully submits that *the Office Action has failed to establish a prima facie case of anticipation in Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102 with respect to Call because Call fails to identically disclose each and every element of Applicant's claimed invention, arranged as they are in Applicant's claims.*

### **III. Applicant's Claims are Patentable over Call**

Applicant respectfully submits that Claims 12, 23, 34, 36 and 37 are considered patentably distinguishable over *Call* for at least the reasons discussed above in connection with Claim 1.

Furthermore, with respect to dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33: dependent Claims 2-7 and 9-11 depend from Claim 1 and are considered patentably distinguishable over *Call*; dependent Claims 13-18 and 19-22 depend from Claim 12 and are considered patentably distinguishable over *Call*; dependent claims 24-29 and 31-33 depend from Claim 23 and are considered patentably distinguishable over *Call*. Thus, dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, Applicant respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are not anticipated by *Call*. Applicant further respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are in condition for allowance. Thus, Applicant respectfully request that the rejection of Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102(b) be reconsidered and that Claims 1-7, 9-18, 20-29, and 31-37 be allowed.

#### IV. **Rejection Under 35 U.S.C. § 103(a)**

Dependent Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of *Sahai*. Applicant respectfully traverses the Examiner's rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) over *Call* in view of *Sahai*.

As discussed in detail above, *Call* fails to disclose at least “*a first product classification schema . . . comprising a taxonomy comprising a hierarchy of classes categorizing one or more products*” of Claim 1. Likewise, *Sahai* fails to provide at least this missing element. As such, dependent Claims 8, 19, and 30, which depend from Claims 1, 12, and 23 having similar limitations are patentably distinguishable over *Call* and *Sahai*, taken either individually or in combination.

##### A. **Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Call-Sahai* Combination According to the UPSTO Examination Guidelines**

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Call* or *Sahai*, whether taken individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “***ensure that the written record includes findings of fact*** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “***factual findings made by Office personnel are the necessary underpinnings to establish obviousness.***” (*id.*). Further, “***Office personnel must provide an explanation to support an obviousness rejection*** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject Application, the Office Action has not shown the ***factual findings necessary to establish obviousness*** or even ***an explanation to support the obviousness rejection*** based on the proposed combination of *Call* and *Sahai*, either individually or in combination. The Office Action merely states that “it would have been obvious . . . to ***apply the statistical technique disclosed by Sahai into the system of Call.***” (24 April 2009 Non-Final Office Action, page 6). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the ***factual findings necessary to establish obviousness*** and is not a sufficient ***explanation to support the obviousness rejection*** based on the proposed combination of *Call* and *Sahai*. ***Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.*** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (*See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill. Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.*** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and *See* 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant’s invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Call and Sahai, either individually or in combination, and Applicant’s claimed invention, would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that “the combined system will be upgraded to use the well-known statistical correlation techniques to identify portions of the target data...such that the combined system will provide a more precise response to the user in a decentralized manner.” (24 April 2009 Non-Final Office Action, page 6). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between***

*the proposed combination of Call and Sahai, either individually or in combination, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*

Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious.* For example, the *Examiner has not adequately supported the selection and combination*



*of Call and Sahai to render obvious Applicant's claimed invention.* The Examiner's unsupported conclusory statements that "it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the statistical technique disclosed by *Sahai* into the system of *Call*," ***does not adequately provide clear articulation of the reasons why Applicant's claimed invention would have been obvious.*** (24 April 2009 Non-Final Office Action, page 6). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obviousness rejection based on the proposed combination of *Call* and *Sahai*, ***Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.***

**B. *Call and Sahai, Individually and in Combination, Fail to Teach Various Limitations Recited in Applicant's Claims***

Applicant respectfully submits that dependent Claims 8, 19 and 30 are considered patentably distinguishable from *Call*. *Call*, as acknowledged by the Examiner, does not teach the unique and novel limitations taught in Claims 8, 19 and 30. This being the case, dependent Claims 8, 19 and 30 are considered patentably distinguishable over *Call*.

With further respect to dependent Claims 8, as mentioned above, dependent Claim 8 depends from Claim 1, is considered patentably distinguishable over the *Call-Sahai* combination, and is considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 8, 19 and 30 are not obvious over *Call and Sahai*, alone or in combination. Applicant further respectfully submits that Claims 8, 19 and 30 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) be reconsidered and that Claims 18, 19 and 30 be allowed.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

15 July 2009  
Date

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